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Paper No.

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MINNEAPOLIS, MN 55402

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APR 21 2004

In re Application of :
Luyken, Seitz, Preece, Weber and Schmid :
Application No. 10/600,750 :
Filed: June 19, 2003 :
Title of Invention: :
CIRCUIT ELEMENT HAVING A FIRST LAYER :
COMPOSED OF AN ELECTRICALLY INSULATING :
SUBSTRATE MATERIAL, A METHOD FOR :
PRODUCING A CIRCUIT ELEMENT, :
BISPYRIDINIUM COMPOUNDS AND THEIR USE IN :
CIRCUIT ELEMENTS :

OFFICE OF PETITIONS
DECISION REFUSING
STATUS UNDER
37 CFR 1.47

This is in response to a petition under 37 CFR 1.47(a), filed February 10, 2004, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s).

The petition is dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on June 19, 2003, without a fully executed oath or declaration. The Office mailed a Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice"), on September 16, 2003, requiring *inter alia*, an executed oath or declaration.

In response to the Notice, Applicant files the instant petition under 37 CFR 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventors.

In support of the petition the Applicant provides copies of letters from the nonsigning inventor requesting remuneration before signing the declaration.

Applicable Law

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1).

As to item (1), where it is alleged that an applicant refuses to join an application, the applicant must establish that the nonsigning inventor was presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states that

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

MPEP 409.03(d).

As to item (1), applicant failed to show or provide proof that the inventor refused to sign the declaration. Before an inventor can refuse to sign an oath or declaration, he must have been presented with a copy of the application papers (specification, claims and drawings). See MPEP 409.03(d).

Applicant present a copy of the application papers were presented to the inventor.

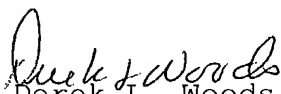
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

By hand: 2201 South Clark Place
Customer Window
Crystal Plaza Two, Lobby Room 1B03
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.


Derek L. Woods
Petitions Attorney
Office of Petitions